

REMARKS

Applicants acknowledge receipt of the Office Action dated November 16, 2004 in which: (1) the drawings were objected to; (2) claims 1-3 and 10-12 were rejected under 35 U.S.C. § 102(b); and (3) claims 1-26 were rejected under U.S.C. § 103(a). In response, Applicants amend the claims and present the following response:

Status of the Claims

Claims 2, 3, 5-12, 14, 15 and 17-26 are in original form.

Claims 1 and 13 are currently amended.

Claims 4 and 16 are canceled.

Objections to the Drawings

The drawings filed by the Applicants on October 27, 2003 were objected to for failing to show every feature of the invention specified in the claims, specifically the “anchor” recited in claim 1, claim 13 and claim 23. In response, Applicants submit concurrently herewith a ***Replacement Sheet*** of Figure 7, which has been amended to show the anchor 40. Accompanying updates have also been made to the specification. Applicants respectfully submit that these amendments address the drawing objection, and therefore request approval of the ***Replacement Sheet*** of Figure 7.

Claim Rejections Under 35 USC § 102(b) in view of Lee et al. and Ross et al.

Pending claims 1-3 and 10-12 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,826,651 to Lee, et al. (hereinafter *Lee*). The Office Action states that *Lee* discloses a method for setting a whipstock and milling a lateral bore from a well, including running a tool that has an anchor (16) a whipstock (14) a cutting tool (22) and a motor (36) into the well, and wherein the tool is oriented and the anchor is set without operating the motor.

In response, Applicants respectfully submit that independent claim 1 is novel over *Lee* at least because *Lee* fails to teach or suggest a method comprising running an assembly including an

anchor, a whipstock, a cutting tool, and a motor into the main well bore as recited by claim 1. Instead, *Lee* discloses a method of setting an anchor before running a whipstock, a cutting tool and a motor into the main well bore. In particular, *Lee* explains that a packer is first set in the wellbore at a desired location, then the packer's orientation is checked by a gyroscope indicator, then a stinger at the bottom of a whipstock-mill combination is properly oriented with the concave face of the whipstock, and finally the whipstock-mill combination is run into the wellbore so that the stinger engages the packer for proper orientation (Col. 2, lines 13-17). As such, *Lee* teaches a method of running and setting an anchor within the well bore in a separate trip from running an assembly comprising a whipstock, a cutting tool, and a motor into the main well bore. Thus, at least because *Lee* fails to teach or suggest a method comprising running an assembly including an anchor, a whipstock, a cutting tool, and a motor into the main well bore, *Lee* fails to disclose each and every element of claim 1. Accordingly, Applicants submit that claim 1 is patentably distinguishable over *Lee*. Additionally, Applicants note that pending claims 2, 3 and 10-12 each depend from allowable claim 1. Thus, Applicants respectfully submit that claims 2, 3 and 10-12 are likewise allowable over *Lee*.

Pending claims 1 and 10 also stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,947,201 to Ross et al. (hereinafter *Ross*). The Office Action states that *Ross* discloses a method for setting a whipstock and milling a lateral bore from a well, including running a tool downhole that has an anchor (18) a whipstock (16) a cutting tool (14) and a motor (Col. 2 lines 59-60), wherein the assembly is oriented and the anchor is set without operating the motor. In response, Applicants respectfully submit that independent claim 1 is novel over *Ross* at least because *Ross* fails to teach or suggest a method comprising setting an anchor while flowing a fluid through the motor without operating the motor as recited by claim 1. Instead, *Ross* discloses a method of setting a packer "by application of pressure to the wellbore from the surface after the proper depth and orientation is achieved" (Col. 3, lines 44-46). Therefore, the packer is set by pressuring up the wellbore rather than flowing a fluid through the motor (whether or not operating the motor). Thus, at least because *Ross* fails to teach or suggest a method comprising setting an anchor while flowing a fluid through the motor without operating the motor, *Ross* fails to disclose each and every element of claim 1. Accordingly, Applicants submit that claim 1 is patentably distinguishable over *Ross*. Additionally, Applicants note that pending claim 10 depends from

allowable claim 1. Thus, Applicants respectfully submit that claim 10 is likewise allowable over *Ross*.

Claim Rejections Under 35 USC § 103(a)

All of the pending claims 1-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,443,129 to Bailey et al. (hereinafter *Bailey*) in view of *Lee* and further in view of U.S. Patent No. 3,896,667 to Jeter (hereinafter *Jeter*). In particular, the Office Action states that *Bailey* discloses a method for setting a whipstock and milling a lateral bore from a well, including running a tool downhole that has an anchor (16) a whipstock (14) and a cutting tool (32), wherein the tool is oriented and the anchor is set at a certain fluid pressure, and a second fluid pressure is used to actuate the tool in the drill string. The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the motor of *Lee* in the apparatus of *Bailey*, and further to use the pressure activation system of *Jeter* on the apparatus of *Bailey* in view of *Lee*.

In response, Applicants respectfully submit that the combination of *Bailey* with *Lee* and *Jeter* does not establish a *prima facie* case of obviousness as to independent claims 1, 13 and 24, as amended. According to MPEP 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Assuming for the sake of argument that the combination of *Bailey* with *Lee* and *Jeter* is proper (without conceding such), no *prima facie* case of obviousness has been established as such a combination does not teach or suggest all of the claim limitations. More specifically, such a combination fails to teach or suggest flowing a fluid through a motor without operating the motor according to claim 1, flowing a fluid through a motor while the motor is locked according to claim 13, or flowing a fluid through a motor without rotating the motor according to claim 23.

In particular, *Bailey* teaches an assembly comprising a bypass valve 28 that directs fluid flowing through the drill string 9 at a lower flowrate into the MWD subassembly 24 and then directs fluid flowing through the drill string 9 at a higher flowrate into the hydraulically-actuated anchor-packer 16. If the motor of *Lee* were added to the *Bailey* assembly, nothing would prevent the motor from operating or rotating when fluid flowed therethrough.

The Office Action asserts that the lockable motor and pressure activation system of *Jeter* could be used on the apparatus of *Bailey* in view of *Lee* to render the pending claims 1-26 obvious. As the Office Action points out, *Jeter* discloses a lockable motor and states that “if the drill string includes a fluid motor it may be desirable from time to time to lock the rotor of the motor to the stator so the assembly attached to the rotor can be rotated by the drill string and to later unlock the rotor for continued drilling without having to pull the pipe string out of the hole.” (Col. 1, lines 9-15). However, *Jeter* fails to disclose how such a fluid motor is locked, and neither teaches nor suggests flowing a fluid through the motor when the motor is locked. Instead, *Jeter* discloses several embodiments of an apparatus designed to actuate one or more downhole devices when a preselected pressure condition exists in the drill string (at the apparatus) for a certain duration. In the embodiment depicted in Figures 1-2, the apparatus actuates and deactivates downhole devices via a stepper switch 28. In the other embodiments depicted in Figures 5-8, the apparatus actuates and deactivates downhole devices by supplying or preventing fluid flow to the devices. Thus, *Jeter* teaches signaling to downhole devices that operate in response to signals, and supplying or preventing fluid flow to downhole devices that operate hydraulically. Accordingly, Applicants submit that when considering the lockable motor of *Jeter* in view of the teachings of *Jeter* as a whole, there would be no fluid flow through the motor in the locked position since a fluid motor is operated hydraulically. As such, adding the features of *Jeter* to the assembly of *Bailey* in combination with *Lee* would yield an assembly with a lockable motor that operates or rotates whenever fluid flows therethrough, and that has no fluid flowing therethrough with the motor is locked.

Thus, with respect to independent claim 1, no *prima facie* case of obviousness has been established at least because the combination of *Bailey* with *Lee* and *Jeter* fails to teach or suggest a method comprising setting an anchor while flowing a fluid through the motor without operating the motor. Further, because claims 2, 3 and 5-12 each depend from and incorporate the

limitations of independent claim 1, Applicants respectfully submit that claims 2, 3 and 5-12 are not obvious in view of the prior art of record.

Similarly, with respect to independent claim 13, no *prima facie* case of obviousness has been established since the combination of *Bailey* with *Lee* and *Jeter* fails to teach or suggest a method comprising setting the anchor while flowing a fluid through the motor when the motor is locked. Further, because claims 14, 15 and 17-22 each depend from and incorporate the limitations of independent claim 13, Applicants respectfully submit that claims 14, 15 and 17-22 are not obvious in view of the prior art of record.

Further, with respect to independent claim 23, no *prima facie* case of obviousness has been established since the combination of *Bailey* with *Lee* and *Jeter* fails to teach or suggest a method comprising flowing a fluid through the motor at a first pressure sufficient to set the anchor without rotating the motor. Because claims 24-26 each depend from and incorporate the limitations of independent claim 23, Applicants respectfully submit that claims 24-26 are not obvious in view of the prior art of record.

CONCLUSION

Applicants submit that the grounds of rejection raised in the Office Action dated November 16, 2004 have been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Dallas, Texas.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,


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